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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,391	01/28/2004	Anthony Di Bitonto	B0224.0079	2535
32173 7590 10/08/2008 DICKSTEIN SHAPIRO LLP 1177 AVENUE OF THE AMERICAS (6TH AVENUE) NEW YORK, NY 10036-2714				
EXAMINER NGUYEN, PHONG H				
ART UNIT		PAPER NUMBER		
3724				
MAIL DATE		DELIVERY MODE		
10/08/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/765,391

Applicant(s)

DI BITONTO ET AL.

Examiner

PHONG H. NGUYEN

Art Unit

3724

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1.5-8,16,17,20 and 22-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1.5-8,16,17,20 and 22-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Claims 16 and 28 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the limitation of interconnected top and bottom elongated members belongs to a non elected embodiment in Fig. 1.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 16 and 28 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the hinge in claims 1, 22 and 23 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure

number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 5-8, 16, 17, 20 and 22-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 22 and 23 claim the post comprising two parts connected through a hinge. This limitation is not supported in the original specification.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 16 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 16 and 28 claim the distal ends of the top and bottom elongated members being interconnected. However, the elected species in Fig. 5 shows that the top and bottom elongated members are not interconnected.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 5-8, 17, 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (4,614,031) in view of Litton (Des. 392,419).

Regarding claims 1 and 23, Chen teaches a nail clipper comprising a top elongated member 32 and a bottom elongated member 18 forming cutting edges (20 and 40), a lever 32, a first post 24 (it is to be noted that since the Applicant calls a plate a post, and does not limit the size of the plate relative to the nail clipper, the Examiner considers plate 24 a post), and a second post 50 provided on a lever 32, wherein the first post and the second post connected through a hinge 30. See Figs. 1 and 7.

Chen does not teach a bumper on the bottom surface of the bottom member 24.

Litton teaches providing a bumper on the bottom surface of a bottom member for comfortably holding the nail clipper. See Fig. 1.

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide a bumper as taught by Litton to the bottom surface of the bottom member of Chen so that one can hold the nail clipper comfortably.

Regarding claims 5 and 25, a section of the bumper having a triangular shape is best seen in Fig. 1 in Litton.

Regarding claims 6 and 24, Chen teaches the invention substantially as claimed except for the lever having a thumb accepting depression.

Litton teaches providing a thumb accepting depression on the lever for comfortably holding the nail clipper. See Fig. 1.

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide a thumb accepting depression as taught by Litton to the lever of Chen so that one can hold the nail clipper comfortably.

Regarding claim 7, the cutting edges of the Chen's nail clipper being at an angle with respect to a central longitudinal axis of the elongated member are best seen in Fig. 1 in Chen.

Regarding claims 8 and 27, the cutting edges being disposed at an angle to a central longitudinal axis of the top and bottom elongated members are best seen in Fig. 1 in Chen.

Regarding claims 17 and 29, the top and bottom elongated members not being interconnected at the distal ends (at the lower left of element 42) are best seen in Fig. 1 in Chen.

Regarding claim 22, Regarding claim 1, Chen teaches a nail clipper comprising a top elongated member 32 and a bottom elongated member 18 forming cutting edges (20 and 40), a lever 32, a first post 24 (it is to be noted that since the Applicant calls a plate a post, and does not limit the size of the plate relative to the nail clipper, the Examiner considers plate 24 a post), and a second post 50 provided on a lever 32, wherein the first post and the second post connected through a hinge 30. It is to be noted that the top and bottom elongated members are not interconnected at the lower left of element 42. See Figs. 1 and 7.

Chen does not teach a bumper on the bottom surface of the bottom member 24.

Litton teaches providing a bumper on the bottom surface of a bottom member for comfortably holding the nail clipper. See Fig. 1.

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide a bumper as taught Litton to the bottom surface of the bottom member of Chen so that one can hold the nail clipper comfortably.

Regarding claims 20 and 25, a section of the bumper having a triangular shape is best seen in Fig. 1 in Litton.

Regarding claim 26, a thumb accepting depression is best seen in Fig. 1 in Litton.

Response to Arguments

9. Applicant's arguments with respect to claims 1, 22 and 23 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **PHONG H. NGUYEN** whose telephone number is (571)272-4510. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Timothy V Eley/
Primary Examiner, Art Unit 3724

/P. H. N./
Examiner, Art Unit 3724
September 29, 2008